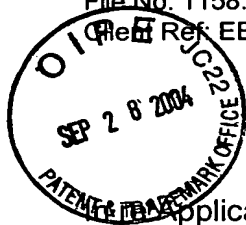


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PATENT



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application of
KITCHEN, et al.

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: Group Art Unit:3622

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: Examiner: R. Alvarez

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Application No:
09/867,587

Filed:

May 31, 2001

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For: BILL AVAILABILITY NOTIFICATION AND BILLING INFORMATION REQUEST

REPLY BRIEF

Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted in response to the Examiner's Answer issued on July
28, 2004.

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REPLY TO EXAMINER'S STATEMENT REGARDING RELATED APPEALS AND INTERFERENCES

The Examiner contends that the Appeal Brief, dated May 3, 2004, does not contain a statement identifying related appeals and interferences. It is respectfully noted that the Examiner is mistaken. Page 2 of the Appeal Brief does in fact contain a statement that there are no related appeals and interferences.

REPLY TO EXAMINER'S STATEMENT REGARDING THE GROUPING OF CLAIMS

The Examiner's position regarding the "grouping of claims" in the Appeal Brief is not understood. Applicants have grouped the claims as desired. However, under the new rules for practice before the Board of Patent Appeals and Interferences, a "grouping of claims" statement is no longer required. Hence, the Examiner's position is now moot and any changes to the "grouping of claims" statement are thus not necessary.

REPLY TO EXAMINER'S RESPONSE TO ARGUMENTS

CLAIMS 37 AND 46

As amended, claim 37 now includes the limitations of claim 34. Thus, claim 37 requires, inter alia:

transmission of a notice indicating availability of billing information and including information indicating a location of the available billing information, this transmission according to an e-mail protocol;

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V

in response to receipt of the notice, transmission of a request to receive the billing information, this transmission according to a protocol other than an e-mail protocol; and

|
V

in response to receipt of the request, transmission of at least a portion of the billing information

Similarly, claim 46 requires, inter alia, that a notice of availability of billing information include information indicating a location of the available billing information on a network. In the Answer the Examiner looks to the disclosure of column 5, line 62, to column 6, line 31, and argues that Hogan teaches a notification of available billing information being sent via e-mail and including information indicating a location of the

available billing information. More particularly, the Examiner contends “Hogan clearly teaches a subscriber receiving an URL/hyperlink of the EBSC’s website which contains available billing information.”

It is respectfully submitted that, as can best be understood, the Examiner has ignored the express requirement that the notice of availability itself include the location information. This is the only reasonable inference that can be drawn from the Examiner’s arguments. First, the Examiner-referenced text does not in any way whatsoever teach or suggest e-mail communications with a subscriber. Rather, all that is disclosed in the Examiner-referenced text is subscriber Web-access of a Web site of the EBSC.

Second, the only e-mail delivery of an URL disclosed in Hogan is found in column 5, lines 44-52, which teaches “a second URL of a particular EBSC web site for bill payment is transmitted to the subscriber via either e-mail or regular mail. The subscriber also receives a userID and password. The userID is for identifying the subscriber when he or she subsequently logs on the server computer to utilize the electronic bill payment service, and the password is for safeguarding against unauthorized access to the subscriber’s bills containing personal information, and against unauthorized payment of such bills.” This URL-containing e-mail is sent as a part of the initialization of (e.g., registration for) the bill presentment and payment service disclosed in Hogan. In other words, this e-mail is sent prior to any bill being available for presentment through the Hogan system. Thus, this URL-containing e-mail

does not include information indicating availability of billing information.

Further, this URL-containing e-mail merely points to a homepage associated with Hogan's system. As discussed in the Appeal Brief, from this home page (shown in Figure 3) a subscriber must access another Web page for presentation of billing information (see detail 203, "receive and pay bills"). Thus, not only does the URL-containing e-mail not include information indicating availability of billing information, but the location to which the URL points fails to include billing information. Rather, another link (detail 203) must be followed even begin to access billing information. Thus, the URL does not identify a location of available billing information.

CLAIMS 35, 41, and 44

As amended, claim 35 now includes the limitations of claim 34. Thus, claim 35 requires, inter alia:

transmission of a notice indicating availability of billing information, this
transmission according to an e-mail protocol;

|
V

in response to receipt of the notice, transmission of a request to receive the
billing information, this transmission according to a protocol other than an e-mail
protocol;

|
V

in response to receipt of the request, formatting the billing information for presentation responsive to receipt of the request; and

|
V

in response to receipt of the request, transmission of at least a portion of the billing information

Similarly, claims 41 and 44 require the formatting of billing information for presentation in response to receipt of a request for the billing information. The Examiner previously relied upon Figure 11 and column 5, line 62, through column 6, line 31, in rejecting claims 35, 41, and 44. Applicants previously argued, in the Appeal Brief and prior responses, that Figure 11 merely depicts an electronic bill presented via e-mail, as described at column 3, lines 33-34, and column 11, lines 16-25. Applicants also previously argued that Hogan clearly teaches that billing information (a bill image) is formatted as soon as it is received from a biller (see column 5, lines 53-57, and column 9, lines 16-25), and that Hogan in no way teaches or suggests formatting in response to a subscriber's request to receive billing information, the request responsive to a notice of availability of that billing information.

In the Answer the Examiner merely repeats a prior response to the above traversal arguments: "[t]he claim doesn't recite that the bill is formatted on the fly. The claim limitation is met by Hogan because in Hogan the user receives an e-mail reminder of the bill that is due and the user is instructed to visit the EBSC website and based on the user requesting the bill information from the website, the bill is formatted and

presented to the user (col. 5, lines 62-, col. 6, lines 1-31).

As pointed out in the appeal brief, the Examiner-referenced text fails to address formatting. Claims 35, 41, and 44 require that billing information be formatted for presentation **in response to a request for the billing information, the request responsive to a notice of availability of that billing information.** The only disclosure in Hogan regarding formatting clearly and unequivocally teaches that billing information is formatted as soon as it is received by Hogan, as noted above. The Examiner yet again fails to point out any disclosure of Hogan that teaches or suggests formatting billing information in response to a request for that billing information.

CLAIMS 40 and 51

Independent claims 40 and 51 require, inter alia:

transmission of an e-mail notice indicating availability of billing information;

|
V

in response to receipt of the e-mail notice, transmission of an e-mail request to
receive the billing information; and

|
V

in response to receipt of the request, transmission of at least a portion of the
billing information

Thus, claims 40 and 51 each require transmission of a notice of availability of billing information via e-mail, transmission of a request for the billing information via e-mail and in response to the notice, and transmission of at least a portion of the billing information in response to the request. The Examiner maintains the argument that the limitations of claims 40 and 51 are taught by Hogan in Figures 1, 10, and 11, and in column 9, lines 7-19 and 61-64. Because of the same grounds of rejection, the previous arguments regarding the patentability of claims 40 and 51, found in the Appeal Brief as well as in prior responses, are incorporated herein.

In the Answer, the Examiner responds to the Applicants' argument that the embodiment of Hogan upon which the Examiner relies in rejecting claims 40 and 51 does not teach an e-mailed request for billing information responsive to an e-mailed notice of availability by arguing "when the subscriber opens the e-mail in essence his [sic] or she is requesting to receive the bill information." It is respectfully submitted that even if the Examiner-referenced e-mail (which it should again be pointed out is a bill) could be construed as a notice indicating availability of billing information, and even if the opening of that e-mail could be construed as a request for billing information, Hogan nonetheless fails to teach or suggest that which is claimed.

How the mere opening an e-mail can possibly be construed to read upon the required responsive transmission, via a network, of a request for available billing information is simply not understood. It can only be assumed, it is respectfully submitted, that the Examiner has ignored the responsive transmission requirement, as the Examiner has failed to even address this limitation.

Further, these claims also require a transmission, via a network, of at least a portion of the available billing information responsive to the request. That is, the bill information is transmitted **after** the request for billing information has been transmitted. The Examiner looks to Figures 9, 10 and 11 for this limitation. As previously argued, these Figures are representations of information that can be displayed on a subscriber's computer **after** billing information has been transmitted to the subscriber via e-mail, not transmissions of billing information in response to a request for that billing information.

In responding, the Examiner argues "after the subscribers open the e-mail and request to receive the billing information then the subscribers will be presented with Figure 9 in which he or she can elect to view and pay his or her bills. Depending on the subscribers election then Figure 10 and 11 will be presented to the subscribers."

The Examiner's position, it is respectfully submitted, cannot be reasonably understood. The Examiner, as discussed above, argues that the opening of the received e-mailed bill constitutes a request for billing information. Thus, the presentation of that received e-mail (after opening) cannot possibly constitute a transmission via a network of the requested billing information, as it has already been transmitted. Simply put, Hogan discloses that an e-mailed bill is received by the subscriber, the subscriber opens that e-mail, and the contents of that e-mail (the bill) are presented to the subscriber.

CLAIMS 43 and 52

Independent claims 43 and 52 require, inter alia:

transmission of a notice indicating availability of billing information, the notice transmitted according to a network protocol other than e-mail;

|
V

in response to receipt of the notice, transmission of request to receive the billing information, the request transmitted according to a network protocol other than e-mail;

and
|
V

in response to receipt of the request, transmission of at least a portion of the billing information

The Examiner maintains the argument that the limitations of claims 43 and 52 are taught by Hogan in Figure 3 and in column 5, line 62, through column 6, line 30. Because of the same grounds of rejection, the previous arguments regarding the patentability of claims 43 and 52, found in the Appeal Brief as well as in prior responses, are incorporated herein.

In the Answer, the Examiner fails to respond to the Applicants' arguments regarding claims 43 and 52 contained in the Appeal Brief. Rather, the Examiner merely repeats the Examiner's prior arguments. Namely, the Examiner fails to address the argument that link 203 (shown in Figure 3 – Hogan's home page) to a user presentation for receiving and paying bills is not a notice of available billing information because link

203 is not selectively displayed, i.e., only presented when billing information is available.

As previously discussed in the Appeal Brief, Hogan teaches that the details of the home page of Figure 3 are always displayed. The home page "furnishes information about the service offered by the provider through use of graphic images, sound, hyperlink choices, etc. With that information, the user is guided through the home page to select the service and desired service features" (column 4, lines 17-22). Thus, there is nothing within Hogan to even suggest that link 203 somehow informs a user of the availability of billing information.

A user selection of link 203 causes a presentation of a first unpaid bill to be transmitted to the user. As disclosed, "if 'Receive and Pay Bills' choice 203 is selected, the program proceeds to step 315 in FIG. 2B where server computer 160 causes display 107 to pull up an image of a first unpaid bill. The first bill, as displayed, is shown in FIG. 4 and illustratively an electric bill from Electric Co. In this preferred embodiment, all the unpaid bills are arranged in chronological order with the bill having the earliest due date displayed first." If no unpaid bills are stored by Hogan, selection of link 203 will not result in the transmission of billing information to the user. Thus, link 203, which is always available via Hogan's home page, is not a notice of available billing information, because link 203 is transmitted to a user (via the Hogan's home page) even if there are no (unpaid) bills to present.

CLAIMS 39 AND 48

It is acknowledged that the Bezos reference teaches a hyperlink to a particular location displayed as an icon. However, as discussed above, Hogan does not teach or suggest a notice of available billing information including information indicating a location of the available billing information on a network. The combination of Hogan and Bezos does not cure this deficiency.

It is again respectfully submitted that the Examiner (i) has failed to establish a prima facie case for the rejections, (ii) failed to reasonably construe that which is taught and suggested by the applied prior art, (iii) has failed to apply art which teaches or suggests the claimed invention, (iv) ignored features explicitly required by claims, and (v) applied art in a manner inconsistent with its teachings.

Thus, the rejection of the pending claims is in error, and reversal is clearly in order, and is courteously solicited.

In view of the Amendment After Final filed herewith, a revised Appendix of Claims Under Appeal is attached hereto.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 01-2135 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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REVISED APPENDIX OF CLAIMS UNDER APPEAL

Claims 1-33 (canceled)

Claim 34: (cancelled)

Claim 35: (Currently Amended) The method of claim 34, further comprising: A method for presenting billing information via a network, comprising:

transmitting a notice according to an e-mail protocol, via a network, indicating availability of billing information;

transmitting a request according to a protocol other than an e-mail protocol, via the network, to receive the billing information responsive to receipt of the notice;

transmitting at least a portion of the billing information, via the network, responsive to receipt of the request; and
formatting the billing information for presentation responsive to receipt of the request.

Claim 36: (Cancelled)

Claim 37: (Currently Amended) The method of claim 34, A method for presenting billing information via a network, comprising:

transmitting a notice according to an e-mail protocol, via a network, indicating availability of billing information;

transmitting a request according to a protocol other than an e-mail protocol, via the network, to receive the billing information responsive to receipt of the notice; and

transmitting at least a portion of the billing information, via the network, responsive to receipt of the request;

wherein the notice includes information indicating a location of the available billing information on the network.

Claim 38: (Previously Presented) The method of claim 37, wherein the information indicating a location of the available billing information is a hyper-link, further comprising:

selecting the hyper-link to transmit the request.

Claim 39: (Previously Presented) The method of claim 38, wherein the hyper-link is an icon.

Claim 40: (Previously Presented) A method for presenting billing information, comprising:

transmitting, via a network, an e-mail notice indicating availability of billing information;

transmitting, via the network, an e-mail request to receive the billing information responsive to receipt of the notice; and

transmitting, via the network, at least a portion of the billing information responsive to receipt of the request.

Claim 41: (Previously Presented) The method of claim 40, further comprising:

formatting the billing information for presentation responsive to receipt of the request.

Claim 42: (Cancelled)

Claim 43: (Previously Presented) A method for presenting billing information,

comprising:

transmitting, via a network, a notice indicating availability of billing information, the notice transmitted according to a network protocol other than e-mail;

transmitting, via the network, a request to receive the billing information responsive to receipt of the notice, the request transmitted according to a network protocol other than e-mail; and

transmitting, via the network, at least a portion of the billing information responsive to receipt of the request.

Claim 44: (Previously Presented) The method of claim 43, further comprising:

formatting the billing information for presentation responsive to receipt of the request.

Claim 45: (Cancelled)

Claim 46: (Previously Presented) The method of claim 43, wherein the notice includes information indicating a location of the available billing information on the network.

Claim 47: (Previously Presented) The method of claim 46, wherein the information indicating a location of the available billing information is a hyper-link, further comprising:

selecting the hyper-link to transmit the request.

Claim 48: (Previously Presented) The method of claim 47, wherein the hyper-link is an icon.

Claim 49: (Previously Presented) The method of claim 43, wherein the notice and the

request are each transmitted according to a same network protocol other than e-mail.

Claim 50 (Cancelled)

Claim 51 (Previously Presented) An system for bill presentment, comprising:

- a memory configured to store billing information; and
- a processor configured to transmit a notice to a payer via e-mail indicating availability of a bill and to receive a request from the payer via e-mail for the available bill;

- wherein the request is transmitted responsive to receipt of the notice; and

- wherein the bill is transmitted to the payer responsive to receipt of the request.

Claim 52: (Previously Presented) A system for bill presentment , comprising:

- a memory configured to store billing information; and
- at least one processor configured to transmit, via a network protocol other than an e-mail protocol, a notice to a payer indicating availability of billing information, and to receive a request, via a network protocol other than an e-mail protocol, from the payer to receive the billing information;

- wherein the request is transmitted responsive to receipt of the notice; and

- wherein the bill is transmitted to the payer responsive to receipt of the request.

Claim 53: (Previously Presented) The system of claim 52, wherein the notice and the request are each transmitted according to a same network protocol other than an e-mail protocol.